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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/004,155	10/19/2001	Charles N. Serhan	7214.08	9126

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EXAMINER
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JONES, DWAYNE C

ART UNIT	PAPER NUMBER
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1614

DATE MAILED: 05/21/2003

10

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No

10/004,155

Applicant(s)

SERHAN, CHARLES N.

Examiner

Dwayne C Jones

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 17-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 17-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Status of Claims***

1. Claims 17-32 are pending.
2. Claims 17-32 are rejected.

### ***Response to Arguments***

3. Applicant's arguments filed April 1, 2003 have been fully considered but they are moot in view of the new rejection under 35 U.S.C. 112, first paragraph, see below.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 25-27, 31-33, 37-39, 43, 45 and 47 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.
6. Claims 25-27, 31-33, 37-39, 43, 45 and 47 describe a method of treating a disease or condition associated with TNF-alpha. The instant claims cover all lipoxin compounds having the pharmaceutical property of being known treating a disease or

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condition associated with TNF-alpha. Describing a compound by its function will not substitute for the written description of the structure of the compound. The invention should be described in such a way as to describe what the invention is, not what the invention does. Describing the function of a compound fails to distinguish the compound from other molecules that can perform the same function.

7. Undue experimentation is a conclusion reached by weighing the noted factual considerations set forth below as seen in *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988). A conclusion of lack of enablement means that, based on the evidence regarding a fair evaluation of an appropriate combination of the factors below, the specification, at the time the application was filed, would not have taught one skilled in the art how to make and/or use the full scope of the claimed invention without undue experimentation.

These factors include:

- (A) The breadth of the claims;
- (B) The nature of the invention;
- (C) The state of the prior art;
- (D) The level of one of ordinary skill;
- (E) The level of predictability in the art;
- (F) The amount of direction provided by the inventor;
- (G) The existence of working examples; and
- (H) The quantity of experimentation needed to make or use the invention based on the content of the disclosure.

#### **The breadth of the claims – The nature of the invention**

8. Claims 25-27, 31-33, 37-39, 43, 45 and 47 are directed to a method of treating a disease or condition associated with TNF-alpha with lipoxin analogs. The instant claims cover all compounds having the pharmaceutical property of being known as treating a

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disease or condition associated with TNF-alpha with lipoxin analogs. These claims do not adequately provide a written description as to what are the specific diseases or conditions that are associated with TNF-alpha with the instantly claimed lipoxin analog. The instant claims are very broad. These claims are directed to a plethora of diseases and conditions as described by having the functional properties as being known as a disease or condition associated with TNF-alpha. The breadth of claims was a factor in Amgen v. Chugai Pharm. Co., 927 F.2d 1200, 18 USPQ2d (Fed. Cir.), cert. Denied, 502 U.S. 856 (1991). In the Amgen case, the patent claims were directed to DNA sequences that encoded amino acid sequences. Because a very small change in the amino acid sequence of a protein can result in a very large change in the structure-function activity of a protein and because the laws of protein folding are in such a primitive state, predicting protein structure (and hence, activity) while knowing only the sequence of the protein is akin to predicting the weather for a date in the future.

#### **The state of the prior art**

9. The prior art reference of Lloyd et al. disclose that cytokines trigger an inflammatory response.

#### **The level of one of ordinary skill**

10. The skilled artisan in this field is high, such as that of a PhD in Biochemistry. The instant claims encompass a vast number of compounds that are purported to be effective in treating a disease or condition associated with TNF-alpha with lipoxin analogs rather than listing specific diseases which can be treating with these lipoxin analog compounds.

**The level of predictability in the art**

11. The prior art appears to be silent to the predictability of effectively determining what are the specific diseases or conditions that are associated with TNF-alpha. One skilled in the art would not predict from the instant disclosure which diseases or conditions that are associated with TNF-alpha would fall under the umbrella of the functional descriptions of being known as broadly as diseases or conditions that are associated with TNF-alpha. In fact, the courts have made a distinction between mechanical elements function the same in different circumstances, yielding predictable results, chemical and biological compounds often react unpredictably under different circumstances. Nationwide Chem. Corp. v. Wright, 458 F. Supp. 828, 839, 192 USPQ 95, 105(M.D. Fla. 1976); Aff'd 584 F.2d 714, 200 USPQ 257 (5<sup>th</sup> Cir. 1978); In re Fischer, 427 F.2d 833, 839, 166 USPQ 10, 24 (CCPA 1970). Thus, the physiological activity of a chemical or biological compound is considered to be an unpredictable art. For example, in Ex Parte Sudilovsky, the Court held that Appellant's invention directed to a method for preventing or treating a disease known as tardive dyskinesia using an angiotensin converting enzyme inhibitor involved unpredictable art because it concerned the pharmaceutical activity of the compound. 21 USPQ2d 1702, 1704-5 (BDAI 1991); In re Fisher, 427 F.2d 1557, 1562, 29 USPQ, 22 (holding that the physiological activity of compositions of adrenocorticotrophic hormones was unpredictable art; In re Wright, 999 F.2d 1557, 1562, 29 USPQ d, 1570, 1513-14 (Fed. Cir. 1993) (holding that the physiological activity of RNA viruses was unpredictable art); Ex Parte Hitzeman, 9 USPQ2d 1821, 1823 (BDAI 1987); Ex Parte Singh, 17 USPQ2d

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1714, 1715, 1716 (BPAI 1990). Likewise, the physiological activity of being known broadly as diseases or conditions that are associated with TNF-alpha prior to filing of the instant invention was an unpredictable art.

**The amount of direction provided by the inventor**

12. The instant specification is not seen to provide adequate guidance, which would allow the skilled artisan to extrapolate from the disclosure and examples provided to make and possibly use the claimed composition. The amount of guidance or direction needed to enable the invention is inversely related to the degree of predictability in the art. In re Fisher, 839, 166 USPQ 24. Thus, although a single embodiment may provide broad enablement in cases involving predictable factors, such as mechanical or electrical elements, in cases involving unpredictable factors, such as most chemical reactions and physiological activity, more teaching or guidance is required. In re Fischer, 427 F.2d 839, 166 USPQ 24; Ex Parte Hitzeman, 9 USPQ 2d 1823. For example, the Federal Circuit determined that, given the unpredictability of the physiological activity of RNA viruses, a specification requires more than a general description and a single embodiment to provide an enabling disclosure for a method of protecting an organism against RNA viruses. In re Wright, 999 F.2d 1562-63, 27 USPQ2d 1575. In the instant case, given the unpredictability of the physiological or pharmaceutical activity of being known broadly as diseases or conditions that are associated with TNF-alpha is insufficient for written description. The specification provides no guidance, in the way of written description for diseases or conditions that are associated with TNF-alpha. In re Fisher, 427 F.2d 833, 166 USPQ 18 (CCPA 1970)

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(contrasting mechanical and electrical elements with chemical reactions and physiological activity). See also In re Wright, 999 F.2d 1557, 27 USPQ2d 1510 (Fed. Cir. 1993); In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). This is because it is not obvious from the disclosure of one species, what other species will work. In re Dreshfield, 110 F.2d 235, 45 USPQ 36 (CCPA 1940), gives this general rule: "It is well settled that in cases involving chemicals and chemical compounds, which differ radically in their properties it must appear in an applicant's specification either by the enumeration of a sufficient number of the members of a group or by other appropriate language, that the chemicals or chemical combinations included in the claims are capable of accomplishing the desired result." The article "Broader than the Disclosure in Chemical Cases," 31 J.P.O.S. 5, by Samuel S. Levin covers this subject in detail. A disclosure should contain representative examples, which provide reasonable assurance to one skilled in the art that the compounds fall within the scope of a claim will possess the alleged activity. See In re Riat et al. (CCPA 1964) 327 F2d 685, 140 USPQ 471; In re Barr et al. (CCPA 1971) 444 F 2d 349, 151 USPQ 724.

### **The existence of working examples**

13. As stated above, the specification discloses diseases or conditions that are associated with TNF-alpha but fails to provide an adequate written description of examples of these diseases or conditions that are associated with TNF-alpha.

**The quantity of experimentation needed to make or use the invention based on the content of the disclosure**



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14. The quantity of experimentation needed to be performed by one skilled in the art is yet another factor involved in the determining whether "undue experimentation" is required to make and use the instant invention. "The test is not merely quantitative, since a considerable amount of experimentation is permissible, if it is merely routine, or if the specification in question provides a reasonable amount of guidance with respect to the direction in which the experimentation should proceed." In re Wands, 858 F.2d 737, 8 USPQ2d 1404 (citing In re Angstadt, 537 F.2d 489, 502-04, 190 USPQ 214, 218 (CCPA 1976)). For these reasons, one of ordinary skill in the art would be burdened with undue "painstaking experimentation study" to determine all of the diseases or conditions that are associated with TNF-alpha that would be described in this specification. In view of the information set forth supra, the instant disclosure is not seen to be sufficient to enable the use of any lipoxin compound, which is regarded as having the functional description of being able to treat diseases, or conditions that are associated with TNF-alpha. Thus one skilled in the art could not use the entire scope of the claimed invention without undue experimentation.

15. The rejection of claims 17-32 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention is withdrawn in response to the amendment of April 1, 2003.

***Claim Rejections - 35 USC § 103***

16. The rejection of claims 1 and 25-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Olson et al. in view of Takano et al. is withdrawn in view of the amendment of September 30, 2002.

***Obviousness-type Double Patenting***

17. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

18. The rejection of claims 25-48 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-24 of U.S. Patent No. 6,387,953 is maintained and repeated. Although the conflicting claims are not identical, they are not patentably distinct from each other because U.S. Patent No. 6,387,953 also teaches of lipoxin analogs where the substituents of Q<sub>4</sub>H and Q<sub>3</sub>H are also hydroxy groups and embrace all types of stereochemical orientations of these substituents of Q<sub>4</sub>H and Q<sub>3</sub>H.

19. The rejection of claims 17-32 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over

claims 17-32 of copending Application No. 10/042,043 is also maintained and repeated. Although the conflicting claims are not identical, they are not patentably distinct from each other because copending Application No. 10/042,043 teaches of a generic lipoxin group of compounds. The instant claims differ from copending Application No. 10/042,043 by reciting a specific species and a more limited genus than copending Application No. 10/042,043. However, it would have been obvious to one having ordinary skill in the art to select any of the species of the genus as taught by copending Application No. 10/042,043, including those instantly claimed, because an ordinary artisan would have the reasonable expectation that any of the species of the genus would have similar properties and, thus, the same use as the genus as a whole.

20. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. C. Jones whose telephone number is (703) 308-4634. The examiner can normally be reached on Mondays through Fridays from 8:30 am to 6:00 pm. The examiner can also be reached on alternate Mondays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marianne Seidel can be reached on (703) 308-4725. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

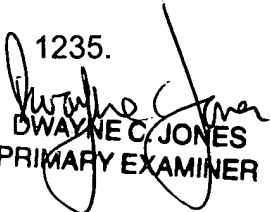
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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-

1235.

  
DWAYNE C. JONES  
PRIMARY EXAMINER

Tech. Ctr. 1614  
May 19, 2003